

REMARKS

Rejection under 35 U.S.C. § 102

Claims 1, 2, 6, 8, 9 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,251,643 (hereinafter referred to as “Osypka”).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicant respectfully submits that the applied reference does not satisfy these criteria.

In Applicant’s response, dated 06/07/2006, Applicant notes that as recited in claim 1, the plurality of conductors are set within the insulative material, before a portion of the insulative material is removed and the second conductive wire is coupled to the first interior conductive wire.

In response to Applicant’s argument, the Office Action states that “there is no claim language that requires the steps to be carried out in the order in which they are written.”

Applicant respectfully disagrees.

Claim 1 recites a first limitation of “providing a cable portion, including a plurality of first conductive wires set into a length of insulative material having a surface, wherein the plurality of conductive wires are disposed at substantially the same radial depth within the insulative material.”

Claim 1 further recites a second limitation of “removing a portion of said insulative material from said surface of said length of insulative material to only one of said conductive wires, thereby creating an exposed first wire surface.”

As seen in the second limitation, the “removing” operates on the provided cable portion which already comprises a plurality of first conductive wires, because the removing causes a surface of one of the wires to be “exposed.” Thus, there is an explicit order recited in claim 1.

Osypka does not disclose each and every limitation of claims 1 and 15.

In a first embodiment of two embodiments of Osypka, band conductor 6 is initially placed against and welded to inner ring conductor 7. *See* FIG. 2. Then, the “convolutions” of wire conductor 3 are disposed over the inner ring conductor 7 and a portion of band conductor 6. *See* FIG. 3. An insulator 9 is “slipped over conductor 7” while band conductor 6 extends through the insulator. *See* FIG. 4. The exact order of the fabrication processes of Osypka is also described in the specification on col. 7, lines 11-33.

In the second embodiment of Osypka, there are two wire conductors 3 and 4 disposed at the same level within the cardiac pacemaker lead as shown in FIG. 5. The second embodiment is similar to the first embodiment in relation to the use of band conductor 6 which is threaded through the various structures. The second embodiment of FIG. 5 seems to primarily differ in the use of additional insulative material to electrically isolate the respective components (i.e., to prevent shorting together of conductors 3 and 4). The fabrication processes of the second embodiment are not disclosed to be substantially different than the fabrication processes of the first embodiment.

Osypka does not remove a portion of said insulative material from a cable that already comprises a plurality of conductive wires to facilitate the desired electrical connection. Instead, Osypka discloses a fabrication procedure in which respective layers of various elements of a cardiac lead are assembled in a successive manner. The fabrication process of Osypka is more cumbersome than the claimed subject matter, imposes additional structural complexity to the lead, and tends to increase the diameter of the lead.

Because Osypka does not remove a portion of said insulative material from a cable that already comprises a plurality of conductive wires to facilitate the desired electrical connection as recited by claims 1 and 15, Osypka does not anticipate claim 1. Claims, 2, 6, 8, 9, and 11 depend from claim 1 and, hence, are also not anticipated.

Rejections under 35 U.S.C. § 103(a)

Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over “Osypka” in view of U.S. Patent No. 5,514,172 (hereinafter referred to as “Mueller”).

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over “Osypka” in view of “Mueller” and further in view of U.S. Patent No. 4,944,088 (hereinafter referred to as “Doan ‘088”).

Claims 7, 10, 12, 13, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over “Osypka” in view of U.S. Patent No. 6,181,971 (hereinafter referred to as “Doan ‘971”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP § 2143. Applicant respectfully submits that the applied references do not satisfy these criteria.

Claim 1 recites:

- a) providing a cable portion, including a plurality of first conductive wires set into a length of insulative material having a surface, wherein the plurality of conductive wires are disposed at substantially the same radial depth within the insulative material;
- b) removing a portion of said insulative material from said surface of said length of insulative material to only one of said conductive wires, thereby creating an exposed first wire surface.

Claim 15 recites:

- a) providing a cable portion, including a plurality of first conductive wires set into a length of insulative material having a surface, wherein the plurality of conductive wires are disposed at substantially the same radial depth within the insulative material;
- b) removing a portion of said insulative material from said surface of said length of insulative material to only a first one of said first conductive wires at a first location, thereby creating a first exposed first wire surface and removing a portion of said insulative material from said surface of said length of insulative material, also

only to said first one of said first conductive wires at a second location, thereby creating a second exposed first wire surface.

For the reasons discussed above in regard to the rejection under 35 U.S.C. § 102, Osypka does not teach or suggest each and every limitation of claims 1 and 15. Mueller, Doan '088, and Doan '971 further fail to teach or suggest each and every limitation of claims 1 and 15. Claims 3-5, 7, 10, 12, and 13 depend from claim 1 and, hence, inherit all limitations of claim 1.

Therefore, the applied references (either individually or in combination) do not teach or suggest each and every limitation of claims 3-5, 7, 10, 12, 13 and 15. A prima facie case of obviousness has not been established for these claims.

Conclusion

Applicant respectfully submits that the application is in condition for allowance and requests the Examiner to pass the application to issue. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 50-3906 from which the undersigned is authorized to draw.

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Respectfully submitted,

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